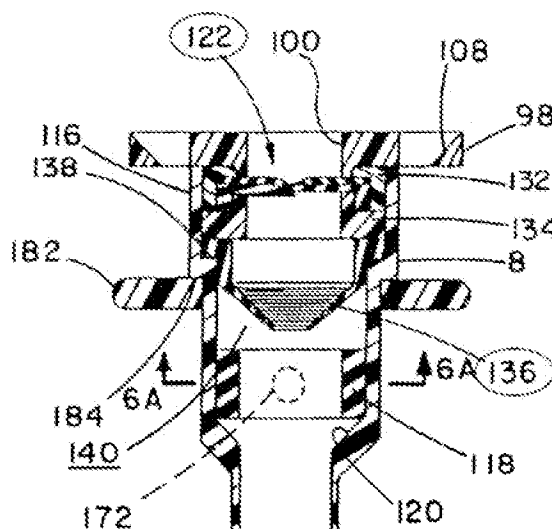


## REMARKS

The claims have been amended as indicated above. The amendments are being made to clarify the invention. The amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

103 Over Haber

The Office Action rejected the pending claims under 35 USC 103 as being obvious over Haber (5,385,552) in view of various other references. Accordingly, all pending rejections are premised on Haber. Applicants traverse these rejections and request reconsideration because the cited portions of Haber do not teach or suggest the combination as currently claimed. A portion of Fig. 4 illustrating the seal structure of Haber is reproduced here with relevant numerals circled. Haber uses two seals: a proximal seal (122) and a distal seal (136). The proximal seal (122) is intended to seal the trocar when an instrument is not positioned in the path (see 6:1-2, 7:39-42, 8:21-22). The proximal seal (122) would be referred to in the art as a “zero-closure seal”. In contrast, the distal seal (136) is conical and intended to seal against surgical instruments when they are positioned in the trocar (see 6:34-37, 7:46-48). The distal seal (136) would be referred to in the art as a “instrument seal”. Accordingly, the distal seal (136) is intended to seal against instruments, not the proximal seal (122).



The Office Action is premised on an inaccurate reading of Haber. Specifically, the Office Action states:

Haber discloses a trocar 2 with a hollow cannula 32 having a distal end and proximal end and a valve housing 58 attached to the proximal end of the cannula, wherein the proximal end has a wall attached thereto having an aperture therethrough, and an instrument seal assembly 122 disposed within said housing . . .

Office Action at 3 (emphasis added). The proximal seal (122) of Haber is not an instrument seal. Rather, it is a zero-closure seal. Haber makes clear that the proximal seal (122) intended to seal the trocar when an instrument is not positioned in the path. Instead, the distal seal (136) of Haber is the instrument seal. Since all rejections are premised on this inaccurate reading of Haber, reconsideration is requested.

The Office Action acknowledges that Haber does not teach or suggest all the claim limitations:

Haber does not expressly disclose each seal segment 126 being gas-tight or sufficiently sealing against instruments positioned through the seal to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures.

Office Action at 3 (emphasis added). Applicants agree with the Examiner because, as discussed above, the proximal seal (122) is a zero-closure seal while the distal seal (136) is an instrument seal. But then the Office Action makes the following statement:

However, it would have occurred to one of ordinary skill in the art to form a tighter seal that would prevent fluid from escaping out the top end of the cannula whether an instrument is present in the cannula or not.

Office Action at 3 (emphasis added). Applicants strenuously disagree. The rejection is premised on the unsupported conclusion that “it would have occurred to one of ordinary skill in the art to form a tighter seal.” The Office Action contains no support that the proximal seal (122) seals against instrument, let alone the desirability to provide a “tighter” seal. In contrast, Haber actually teaches the very opposite. Haber makes clear that the proximal zero-closure seal (122) is not designed to seal against instruments. Instead, Haber requires the addition of a separate distal seal (136) to seal against surgical instruments. So one with ordinary skill reading Haber would be taught away from the invention as presently claimed.

Moreover, the conclusion reached in the Office Action would improperly modify the principle operation of the Haber. MPEP 2143.01(VI). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, Haber makes clear that the proximal seal (122) is a zero-closure seal not designed to seal against instruments. Nevertheless, the rejection is improperly premised on modifying the function of the

proximal zero-closure seal (122) and converting it into an instrument seal. Accordingly, the Office Action has not established a *prima facie* case of obviousness.

Since all of the rejections are premised on Haber, and as discussed above the rejection based on Haber is misplaced, all the claims should be in a condition for allowance.

#### Copending Applications

The Examiner should note the following copending United States patent applications:

<u>Application</u>	<u>Status</u>
10/687502	08-14-2008 CTFR Final Rejection
10/943215	11-07-2008 N/AP Notice of Appeal Filed
10/943214	10-08-2008 CTNF Non-Final Rejection
10/943221	10-14-2008 CTFR Final Rejection
10/943222	10-16-2008 A... Amendment/Req. Reconsideration-After Non-Final Reject
10/943220	09-29-2008 CTFR Final Rejection
11/217673	11-19-2008 A... Amendment/Req. Reconsideration-After Non-Final Reject
10/943218	07-29-2008 CTFR Final Rejection
10/943213	08-11-2008 A... Amendment/Req. Reconsideration-After Non-Final Reject

The foregoing statuses were pulled from PAIR on 12/08/2008. The Examiner is encouraged to review each of these file wrappers, including the pending claims, all art of record, and any rejections. Details of these cases are available through PAIR and the Office's databases. No representation is made or intended that the foregoing cases are material to patentability of the present claims, or that the foregoing list is comprehensive.

#### Conclusion

Based on the foregoing, all of the pending claims are in a condition for allowance. Applicants traverse all rejections and request reconsideration, and Applicants request an early notice of allowability.

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Respectfully submitted,

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